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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,965	03/25/2004	Raghunath Vitthal Chaudhari	A36200-PCT-USA-A; 066123.	7075
21003	7590	04/21/2006	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112			OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/808,965	Applicant(s) CHAUDHARI ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

–The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

THE REPLY FILED 29 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see pages 2-5. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

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It is noted that applicants have filed an Amendment after the Final Rejection on 3/29/06; applicants' attorney has addressed the issues of record. The proposed amendment will not be entered because it raises new issues that would require further consideration and/or search ; and, it is not in a condition for allowance.

The Status of Claims

Claims 1-8, and 11-23 are pending.

Claims 1-8, and 11-23 have been rejected.

The New Issue

The introduction of the new phrase " a palladium phosphine complex" into claims 1,8, and 13 would require further consideration and/or search since the scope of the claimed invention becomes narrower than before.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of Claims 1-8, and 11-23 under 35 U.S.C. 103(a) as being unpatentable over Cesa et al (EP 0144118) in view of Nicholson et al (US 5,744,650) has been maintained.

The rejection of Claims 1-8, and 11-23 under 35 U.S.C. 103(a) as being unpatentable over Cesa et al (EP 0144118) in view of Nicholson et al (US 5,744,650) has been maintained with the reasons of record on 2/10/05.

Applicants' attorney has addressed the issues of record; however, has not rebutted the claim rejections **1-8, and 11-23** under 35 USC 103 (a).

Applicants' Argument

Applicants argue the following issues:

- a. Neither Cesa nor Nicholson disclose the use of a nitrogen or oxygen containing organic compound as a ligand to increase catalytic activity;
- b. Nicholson teaches away from phosphine catalysis in a CO environment.

Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding the first and second arguments, the Examiner has noted applicant's argument. However, the claims are not directed to the increased catalytic activity of the claimed process using nitrogen or oxygen containing organic compounds, but the claims are more directed to the process for preparing a 2-hydroxy carboxylic acid using a reusable catalyst. Furthermore, Cesa et al expressly teaches that when

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using $(\text{P}^{\text{t}})_2\text{PdCl}_2$ or $\text{Pd}(\text{P}^{\text{t}})_4$ catalyst, other palladium compounds, CH_3CN or/ and tetrahydrofuran can be used together during the reaction process(see col. 4 ,lines 30-37); from this, there is still a teaching for the organic ligand surrounding palladium catalyst. Also, concerning phosphine catalysis in a CO environment, the primary Cesa prior art process does point out that when a metal is complexed with a phosphine, the carbonylation and the hydrolysis do take place effectively in the CO environment (see col. 5 ,lines 18-29). Therefore, applicants' arguments are irrelevant to the issue of the invention.

Furthermore, since the newly potentially revised claim claims 1,8, and 13 has a narrower scope of the invention than the previous one , this requires new issues that would require further consideration and/or search. Therefore, the newly amended claims are not going to enter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Myra V. H.
4/19/06